

Remarks

In view of the following amendments and remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 27 remain in this application. Claim 20 has been amended.

**1. Oath/Declaration**

The Examiner has objected to the Declaration under 37 C.F.R. 1.52(c) because alterations were made to the Declaration that were not initialed. An initialed Declaration is being forwarded to the Office in a separate communication.

**2. Claim Objection**

The Examiner has indicated that claim 20 is objected to because of an informality. In particular, the Examiner points out that claim 20 should depend from claim 19 instead of claim 1. In response, the applicant has amended claim 20 to depend from claim 19.

**3. Allowed Claims/Subject Matter**

Applicant notes with appreciation that the Examiner has indicated the subject matter of claims 19, 22 and 26 are patentable, and would be allowable if rewritten in independent form.

**4. § 102 Rejections**

The Examiner has rejected claims 1, 2, 5, 11 – 14, and 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,309,248 to King.

King is directed to a modular electrical component for electrical wiring systems. The modular electrical component includes a removable electrical device, a base unit that fits within a junction box in the electrical wiring system and a mounting strap used to secure the base unit to the junction box. The removable electrical device has a plurality of power contacts that extend from a rear cover of the device, and the base unit has a plurality of terminal connections. The power contacts electrically connect to the terminal connections, when the replaceable electrical device is mated with the base unit.

According to **MPEP 2131**, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner does not make a prima facie case of anticipation because he does not point out where the cited reference discloses each and every element of the claim. For example, claim 1 recites “*a housing configured to accommodate a frame member selected from a plurality of frame members, each frame being configured to accommodate at least one wiring assembly...*” In this instance, the examiner asserts that housing 32 and frame 30 anticipate the housing and frame recited in the claim. However, a comparison of Figures 1, 2, and 3 in King reveals that King does not show one housing configured to accommodate a plurality of frame members. Figure 30a, for example, shows a frame 30a that accepts a light switch 12. Housing 32 in Figure 3 is different than housings shown in Figure 1 or Figure 2. Thus, the Examiner has not made a prima facie case of anticipation because King does not disclose “a housing configured to accommodate a frame member selected from a plurality of frame members, each frame being configured to accommodate at least one wiring assembly,” as recited in claim 1.

King also does not disclose a plurality of frame members as recited in claim 1 because the different frame members 30, 30a disclosed by King require different housing members 32 (Compare Figure 1 with Figure 3).

The Examiner also asserts that King discloses a set of terminal contacts selected from a plurality of sets of contacts, as recited in claim 1. However, King only discloses one set of terminal contacts. See Figure 5. Accordingly, the Examiner does not show where King discloses a plurality of sets of terminal contacts, each of which are matched to accommodate one of the plurality of electrical wiring assemblies.

The dependent claims are also allowable in their own right. For example, the Examiner relies on col. 3, lines 48 – 61 and col. 5, lines 39 – 52 for the proposition that King teaches a wiring device that includes a first switch and a second switch. However, the cited portions of King do not support the Examiner’s assertions. To the contrary, the cited text states that “examples of such electrical devices include grounded receptacles (Fig. 2) and switches (Fig. 3). The applicant notes that Figure 3 shows one switch. Indeed, a review of the Figures in King reveals that there is no wiring device disclosed by King that includes a first

switch and a second switch. Accordingly, the Examiner fails to show where King discloses the subject matter of claim 2. Since claim 5 and claims 11 – 14 depend from claim 2, the Examiner also fails to show where King discloses the subject matter of these claims.

The Examiner also asserts that the multi-gang assembly shown in Figure 9 reads on the subject matter of claim 25. Claim 25 recites a frame having a second opening, not a multi-gang assembly. A review of the Figures of the present invention will reveal that the present invention does not include a multi-gang assembly. Accordingly, the Examiner does not point out where King discloses the subject matter of claim 25.

The Examiner has not made a *prima facie* case of anticipation because he has not shown where King discloses each and every element of the claimed invention. Accordingly claims 1, 2, 5, 11 – 14, and 25 are patentable under 35 U.S.C. § 102(b). The applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

## 5. § 103 Rejections

The Examiner has rejected claims 3, 4, 6 – 10, 15 – 18, 20, 21, 23, 24, and 27 under 35 U.S.C. § 103 as being unpatentable for obviousness over King.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

### A. The prior art reference does not teach or suggest all the claim limitations.

In Section 4 of this response, the applicant has conclusively shown that King does not disclose each and every element of the independent claim 1. Accordingly, even if every thing the Examiner asserts in his obviousness rejection is correct, which it is not, King cannot teach all of the claim limitations of the dependent claims by virtue of their dependency from claim 1.

The dependent claims are also allowable in their own right. For example, claim 3 depends from claim 2 and recites a first switch and a second switch, wherein the second switch is a single pole switch. The Examiner states that it would have been a matter of design choice and states that the invention “would perform equally well if designed with a single pole switch.” The Applicant points out that the Examiner’s has failed to properly fill out the PTO form paragraph boiler plate because claim 3 does recite a single pole switch. In reality, the Examiner is making a tacit admission that King does not include the recited feature. Indeed, the Examiner relies on the “design choice” argument for most of the dependent claims. The applicant respectfully points out that according to both the case law and the MPEP, it is incumbent upon the Examiner to show where the cited reference teaches or suggests each claim element. It is unfair and improper to hide behind the “design choice” argument when, in fact, the reference does not teach the recited claim elements.

**B. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.**

As noted above, in each case, the Examiner provides no suggestion other than it is a matter of design choice to modify the cited reference. For example, in the discussion of claim 3, the Examiner states that “King discloses the invention except for....the second switch being a single pole switch. It would have been a matter of design choice...and it appears that the invention would perform equally well if designed with a single pole switch.” The quoted statement does not make sense and indicates that the Examiner does not understand how to apply a design choice rejection.

**C. Summary**

Accordingly, the Examiner has not made a prima facie case of obviousness because he has not shown where King teach or suggest all the claim limitations in dependent claims 3, 4, 6 – 10, 15 – 18, 20, 21, 23, 24, and 27. Further, the Examiner has not provided any proper motivation to modify the King reference. Accordingly claims 3, 4, 6 – 10, 15 – 18, 20, 21, 23, 24, and 27 are patentable under 35 U.S.C. § 103(a). The applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

**6. Conclusion**

Based upon the amendments, remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 27 and a prompt Notice of Allowance thereon.

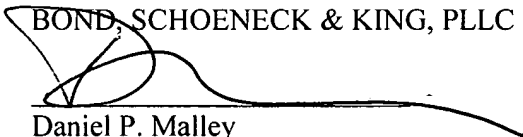
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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